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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,301	02/27/2002	William K. Leonard	56912US002	2113

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EXAMINER	
LAZOR, MICHELLE A	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/087,301	LEONARD, WILLIAM K.	
	Examiner	Art Unit	
	Michelle A Lazor	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *1-29 and 51-57* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 30, 33, 34, and 36 – 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 63 – 65, 67, and 68 of copending Application No. 09757955. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are claiming a device with three or more rotating rolls or devices that can periodically contact and re-contact the coating at different positions on a substrate, wherein the periods are not periodically related; wherein the periods are selected so that the uniformity of the coating is improved; and wherein the coating station initially applies a discontinuous or uneven coating.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 30, 32, 33, 35, 42 – 45, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (U.S. Patent No. 2570173).

Regarding Claims 30, 32, 33, Von Kohorn discloses a device comprising a coating station (20) that directly sprays a substantially uneven coating to at least some of the exposed portion of a filamentous article and an improvement station comprising two or more rotating rolls (21) that periodically contact and re-contact the wet coating at different positions along the length of the filamentous article (Figure; column 4, lines 4 – 20); Von Kohorn also discloses the coating station which is capable of periodically applying the coating liquid, and of changing the application period by turning the spray nozzles on and off. Thus Von Kohorn discloses all the limitations of Claims 30, 32, 33, and anticipates the claimed invention.

Regarding Claims 35, 42 – 45 and 48, Von Kohorn discloses the rolls have the same period of contact with the filamentous article, wherein the filamentous article has a direction of motion and the direction of rotation of all the rolls is the same as the direction of motion, wherein there is substantially no slippage between the rolls and the filamentous article; and wherein a voided coating is applied to the filamentous article and converted by contact with the rolls to a void-free coating (Figure; column 4, lines 4 – 23). Thus Von Kohorn discloses all the limitations of Claims 35, 42 – 45 and 48, and anticipates the claimed invention.

5. Claims 30 – 33, 36 – 45, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Severini (U.S. Patent No. 2867108).

Regarding Claims 30 – 33, Severini discloses a device comprising a coating station (16) that indirectly sprays by means of a shower nozzle or drips by means of a pipe (column 4, lines 43 – 48) a substantially uneven coating to at least some of the exposed portion of a filamentous article and an improvement station comprising two or more rotating rolls (10) (11) that periodically contact and re-contact the wet coating at different positions along the length of the filamentous article (Figures 1 and 2; column 4, lines 43 – 62 and column 5, lines 16 – 37); Severini also discloses the coating station which is capable of periodically applying the coating liquid, and of changing the application period by turning the spray nozzles on and off. Thus Severini discloses all the limitations of Claims 30 – 33, and anticipate the claimed invention.

Regarding Claims 36 – 45 and 48, Severini discloses the rolls that do not have the same period of contact with the filamentous article, wherein the rolls all have different periods of contact with the filamentous article and wherein the rotational periods of the rolls are not periodically related; wherein the filamentous article has at least 13 contacts with the rolls following application of the substantially uneven coating (Figures 1 and 2), wherein the filamentous article has a direction of motion and the direction of rotation of all the rolls is the same as the direction of motion, wherein there is substantially no slippage between the rolls and the filamentous article; and wherein a voided coating is applied to the filamentous article and converted by contact with the rolls to a void-free coating (Figures 1 and 2; column 3, line 66 – column 4, line 11). Thus Severini discloses all the limitations of Claims 36 – 45 and 48, and anticipates the claimed invention.

6. Claims 30 – 34, 36, 38, 39, 42 – 46, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Guertin (U.S. Patent No. 5034250).

Regarding Claims 30 – 33, Guertin discloses a device comprising a coating station (21) that directly sprays or drips a substantially uneven coating to at least some of the exposed portion of a filamentous article and an improvement station comprising two or more rotating rolls (10) (11) (18) that periodically contact and re-contact the wet coating at different positions along the length of the filamentous article (Figure; column 2, lines 56 – 66); Guertin also discloses the coating station which is capable of periodically applying the coating liquid, and of changing the application period by turning the spray nozzles on and off. Thus Guertin discloses all the limitations of Claims 30 – 33, and anticipate the claimed invention.

Regarding Claims 34, 36, 38, and 39, Guertin discloses at least three rolls, wherein the rolls do not have the same period of contact with filamentous article; wherein the rotational periods of the rolls are not periodically related; and wherein the filamentous article has at least five contacts with the rolls following application of the substantially uneven coating (Figure). Thus Guertin discloses all the limitations of Claims 34, 36, 38, and 39, and anticipate the claimed invention.

Regarding Claims 42 – 46 and 48, Guertin discloses the filamentous article has a direction of motion and the direction of rotation of all the rolls is the same as the direction of motion, wherein there is substantially no slippage between the rolls and the filamentous article; wherein at least one of the rolls is grooved; and wherein a voided coating is applied to the filamentous article and converted by contact with the rolls to a void-free coating (Figure; column

2, line 56 – column 3, line 15). Thus Guertin discloses all the limitations of Claims 42 – 46 and 48, and anticipates the claimed invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 31 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Von Kohorn.

Von Korn discloses using a coating station (20). The sprayers of the coating station are considered capable of dripping an uneven coating to at least some of the exposed portion of a filamentous article. In any event, it would have been obvious to use dripping means to conserve coating material and prevent excess coating material from being wasted in the coating area by spraying.

9. Claim 31 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guertin.

Guertin discloses using a coating station (21). The sprayers of the coating station are considered capable of dripping an uneven coating to at least some of the exposed portion of a filamentous article. In any event, it would have been obvious to use dripping means to conserve coating material and prevent excess coating material from being wasted in the coating area by spraying.

10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guertin as applied in Claim 30 above, in view of Guillermin et al. (U.S. Patent No. 4059068).

Guertin discloses all the limitations of Claim 30, but does not specifically disclose all of the rolls to have grooves. However, Guillermin et al. teaches using grooved rolls for treatment of filamentary products (column 1, lines 37 – 43). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use grooves for all the rolls of the treatment apparatus to reduce friction (column 1, line 39) and to place the filamentary product in a desired location.

Response to Arguments

11. With respect to the double patenting rejection, while claims have been withdrawn in Application No. 09757955, claims have not been canceled, and are still pending.

12. In response to applicant's argument that Von Kohorn does not anticipate a substantially uneven coating to the yarn, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The apparatus disclosed by Von Kohorn is *capable* of spraying a substantially uneven coating to at least some of the exposed portion of a filamentous article. Although Von Kohorn does not specifically speak to applying an uneven coating, as stated in the previous Office Action the

spray nozzles may be turned on and off, thereby providing an uneven coating, as well as periodically applying the coating liquid. In addition, by applying an uneven coating to yarn using spray nozzles that are turned on and off, and then contacting said yarn with rolls as disclosed by Von Kohorn, one in the art would know the uneven or voided coating would be converted to a void-free coating.

13. Again, in response to applicant's argument that Severini and Guertin do not anticipate a substantially uneven coating to the yarn, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Although both Severini and Guertin does not specifically speak to applying an uneven coating, as stated in the previous Office Action the spray nozzles may be turned on and off, thereby providing an uneven coating, as well as periodically applying the coating liquid. In addition, by applying an uneven coating to yarn using spray nozzles that are turned on and off, and then contacting said yarn with rolls as disclosed by both Severini and Guertin, one in the art would know the uneven or voided coating would be converted to a void-free coating.

14. In response to applicant's argument that the apparatus disclosed by Von Kohorn and Guertin does not drip an uneven coating to at least some of the exposed portion of a filamentous article, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since the prior art structure disclosed by both Von Kohorn and Guertin is capable of dripping an uneven coating to at least some of the exposed portion of a filamentous article, both Von Kohorn and Guertin render Claim 31 unpatentable.

15. Regarding the rejection of Claim 47 under 35 USC §103(a), Examiner again respectfully disagrees for reasons stated above for Guertin.

16. Regarding the rejection of Claims 49 and 50 under 35 USC §103(a), Examiner agrees with Applicant, and therefore withdraws the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 703-305-7976; after 12/19/03, telephone number will be 571-272-1232. The examiner can normally be reached on Mon - Thurs 6:30 - 4:00, Fridays 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

MAL
12/1/03

RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700